APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,123	09/17/2003	Shantanu Sardesai	MS1-1613US	7155

22801   7590   10/23/2007

LEE & HAYES PLLC
421 W RIVERSIDE AVENUE SUITE 500
SPOKANE, WA 99201

EXAMINER
VO, TED T

ART UNIT	PAPER NUMBER
2191	

MAIL DATE	DELIVERY MODE
10/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/667,123	SARDESAI ET AL.
	Examiner	Art Unit	
	Ted T. Vo	2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>7/24/07</u>.

2a)☒ This action is **FINAL.** 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-76</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-76</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>4/20/07</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the communication filed on 07/24/2007.

Claims 1-76 are pending in the application.

Response to Arguments

2.   Applicants' arguments and amendment in the remarks on 07/24/2007 have been considered.

- With regard to the rejection to the claims under 112 second paragraph:

Claims 18 and 36, Claims contain the trademark/trade name <u>WinPE™ operating system</u> as a limitation. This limitation in the claims is, "wherein the pre-installation environment **comprises WinPE ™ operating system**". The trade name <u>is used as a limitation</u> to identify/describe a product itself. Trademark or trade name is used in a claim <u>as a limitation to identify or describe a particular material or product</u>, the claim **does not comply** with the requirements of 35 U.S.C. 112, second paragraph.

Claims 1-10, 22-24, 25-31, 32-34, 42-58, 64-68, 74-76, are indefinite in accordance to the rationale in the prior office action and in this present office action. Examiner has reviewed the Applicants' remarks in p. 36 – p. 39. However, the Applicant's remarks have been failed in response to the addresses of the Examiner in the prior office action. The identified Claims in the rejection under 112 second paragraph contain unclear limitation as identified in the office action. Thus, the functionality of claims will be unclear. Some identified claims have the improper independency. For example, See Claim 8-9, and others, where claim 1 is a method but the cope of claim 8 is a medium, and Claim 9 is a program per se.

It should be noted that claiming a program per se fails under 101 issue.

Because the scope under the dependency is unclear; therefore, it will be rejected as being indefinite.

The rejection of claims 1-10, 22-24, 25-31, 32-34, 42-58, 64-68, 74-76 and claims 18 and 36,

using trade name as limitation, is proper under 35 USC 112 second paragraph.

- With regards to the rejection of claims 1-24, 69-76 are rejected under 35 U.S.C. 102(b) as being

anticipated by Sun Microsystems (Hereafter Sun): "JumpStart™ Mechanics: Using JumpStart Application

for Hands-Free Installation of Unbundled Software": Applicants fail to fully respond but merely allege that

JumpStart teaches certain packages are deleted.

In the remarks, it appears the argument regards that "Deletion of an old operating system" is

novelty and patentability of the application, and Applicants' argument merely argue that deleting certain

packages is not deleting an old operating system. Examiner noted that "deleting" is not a patentable

feature because originally computer has provided a user the ability to delete any file stored in the

computer. This cannot be a patentable feature. In fact, any user can achieve the recitations of the claims

manually. The argument fails to fully respond as requires by 1.111(c).

- With regards to the rejection of Claims 25-49 are rejected under 35 U.S.C. 102(a) is now under

103(a) as necessitated by the amendment.

- With regards to the rejection of Claims 50-68 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Pawlak, "Software Update Service to Ease Patch Distribution",

DirectiononMicrosoft.com, in view of Sun Microsystems (Hereafter Sun): "JumpStart™ Mechanics: Using

JumpStart Application for Hands-Free Installation of Unbundled Software", (hereinafter Part1);

"JumpStart™ Mechanics: Using JumpStart Application for Hands-Free Installation of Unbundled

Software – Part 2" (hereinafter Part2): Nowhere in the remarks it responds to this rejection. Applicants'

argument and amendment are non-responsive.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claims 1-10, 18, 22-24, 25-31, 32-34, 36, 42-58, 64-68, 74-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It should be noted that the Federal Circuit recently ruled that a method claim, which depended from an apparatus or system claim, was invalid under 35 U.S.C. §112, 2d para., because it mixes statutory classes. *IPXL Holdings, LLC v. Amazon.com, Inc.,* 2005 U.S. App. Lexis 25120 (Fed. Cir. 2005). Such claim is fatally flawed because it is unclear whether infringement occurs by the manufacturer making the system capable of doing the method or when the method is actually used by the user.

As per Claims 18 and 36 contain the trademark/trade name WinPE™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson,* 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a trade product and, accordingly, the identification/description is indefinite.

Claims <u>1-9, 10, 25-31, 32-34, 42-48, 50-58</u> have the limitation, **"re-booting the target computer in the pre-installation environment"**.

It should be noted that re-booting is a process of initialization of a computer, such as restarting a computer. It should be noted that "target computer" is a physical element while "pre-installation environment" is only an environment, and it is only **on** "a target computer". How can this limitation, "re-booting the target computer in the pre-installation environment", be illustrated? Is it rebooting the target computer? This claimed limitation is unclear.

Claims 8-9 should be implemented under an independent scope and set forth how its scope could perform or generate the steps set forth in claim 1. Merely including the steps of the claim 1 in a product will cause confusion. For example, Claim 9 might be non-statutory because its scope is a program per se. The claims are indefinite because there is insufficient antecedent basis in the claims in connecting to a method of claim 1. See Product and process in the same claim (MPEP 2173).

Claim 10 is claiming a system having target computers and each target computer having a readable medium. The Claims is mixed with a method. This type of the claim is indefinite because it does not know the claim is a method or a system. See Product and process in the same claim (MPEP 2173).

Claims 22-23 are indefinite. They should be implemented in independent scopes and each claim should set forth how its scope could perform or generate the steps set forth in claim 11. Merely including the steps of the claim 11 in a product will cause confusion. For example, Claim 23 might be non-statutory because its scope is a program per se. The claims are indefinite because there is insufficient antecedent basis in the claims in connecting to a method of claim 11. See Product and process in the same claim (MPEP 2173).

Claim 24 is claim a system with more than one target computers, and a computer readable is installed in each target computer. The Claims is then mixed with a method for use. This type of the claim is indefinite because it does not know the claim is a method or a system. See Product and process in the same claim (MPEP 2173). Furthermore, the claim recites, "cause the one or more processors to perform a method comprising: using a multi-phase...", the meaning is unclear.

Claims 30-31 should be implemented in independent scopes and each claim should set forth how its scope could perform or generate the steps set forth in claim 25. Merely including the steps of the claim 25 in a product will cause confusion. For example, Claim 31 might be non-statutory because its

scope is a program per se. The claims are indefinite because there is insufficient antecedent basis in the claims in connecting to a method of claim 25. See Product and process in the same claim (MPEP 2173).

Claims 33-34 should be implemented in independent scopes and each claim should set forth how its scope could perform or generate the steps set forth in claim 32. Merely including the steps of the claim 32 in a product will cause confusion. For example, Claim 34 might be non-statutory because its scope is a program per se. The claims are indefinite because there is insufficient antecedent basis in the claims in connecting to a method of claim 32. See Product and process in the same claim (MPEP 2173).

Claims 39-40 should be implemented in independent scopes and each claim should set forth how its scope could perform or generate the steps set forth in claim 35. Merely including the steps of the claim 35 in a product will cause confusion. For example, Claim 40 might be non-statutory because its scope is a program per se. The claims are indefinite because there is insufficient antecedent basis in the claims in connecting to a method of claim 35. See Product and process in the same claim (MPEP 2173).

Claim 41 is claiming a system with more than one target computers, and a computer readable is installed in each target computer. The Claims is then mixed with a method for use. This type of the claim is indefinite because it does not know the claim is a method or a system. See Product and process in the same claim (MPEP 2173).

Claims 47-48 should be implemented in independent scopes and each claim should set forth how its scope could perform or generate the steps set forth in claim 42. Merely including the steps of the claim 42 in a product will cause confusion. For example, Claim 48 might be non-statutory because its scope is a program per se. The claims are indefinite because there is insufficient antecedent basis in the claims in connecting to a method of claim 42. See Product and process in the same claim (MPEP 2173).

Claim 49 is claiming a system with more than one target computers, and a computer readable is installed in each target computer. The Claims is then mixed with a method for use. This type of the claim is indefinite because it does not know the claim is a method or a system. See Product and process in the same claim (MPEP 2173).

Claims 56-57 should be implemented in independent scopes and each claim should set forth how its scope could perform or generate the steps set forth in claim 50. Merely including the steps of the

claim 50 in a product will cause confusion. For example, Claim 57 might be non-statutory because its scope is a program per se. The claims are indefinite because there is insufficient antecedent basis in the claims in connecting to a method of claim 50. See Product and process in the same claim (MPEP 2173).

Claim 58 is claiming a system with more than one target computers, and a computer readable is installed in each target computer. The Claims is then mixed with a method for use. This type of the claim is indefinite because it does not know the claim is a method or a system. See Product and process in the same claim (MPEP 2173).

Claims 64-65 should be implemented in independent scopes and each claim should set forth how its scope could perform or generate the steps set forth in claim 59. Merely including the steps of the claim 59 in a product will cause confusion. For example, Claim 65 might be non-statutory because its scope is a program per se. The claims are indefinite because there is insufficient antecedent basis in the claims in connecting to a method of claim 59. See Product and process in the same claim (MPEP 2173).

Claims 66-68 claim a system with more than one target computers, and a computer readable is installed in each target computer. The Claims is then mixed with a method for use.

This type of the claim is indefinite because it does not know the claim is a method or a system. See Product and process in the same claim (MPEP 2173).

Claims 74-75 should be implemented in independent scopes and each claim should set forth how its scope could perform or generate the steps set forth in claim 69. Merely including the steps of the claim 69 in a product will cause confusion. For example, Claim 75 might be non-statutory because its scope is a program per se. The claims are indefinite because there is insufficient antecedent basis in the claims in connecting to a method of claim 69. See Product and process in the same claim (MPEP 2173).

Claim 76 is claiming a system with more than one target computers, and a computer readable is installed in each target computer. The Claims is then mixed with a method for use. This type of the claim is indefinite because it does not know the claim is a method or a system. See Product and process in the same claim (MPEP 2173).

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for

the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a
printed publication in this or a foreign country, before the invention thereof by the applicant for a
patent.
(b) the invention was patented or described in a printed publication in this or a foreign country or
in public use or on sale in this country, more than one year prior to the date of application for
patent in the United States.

6.   Claims 1-24, 69-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Sun

Microsystems (Hereafter Sun): "JumpStart™ Mechanics: Using JumpStart Application for Hands-Free

Installation of Unbundled Software", (hereinafter Part1);

"JumpStart™ Mechanics: Using JumpStart Application for Hands-Free Installation of Unbundled

Software – Part 2" (hereinafter Part2);

and "Upgrading to the Solaris™ 8 Operating Environment" (hereinafter Part3);

See in http://68-191-184-102.dhcp.stpt.wi.charter.com/books/blueprints/browses.htm

(http://www.directionsonmicrosoft.com/sample/DOMIS/update/2002/05may/0502sustep.htm).

As per claims 1-9:

- Sun discloses claim 1, and thus claims 8-9, for installing, a pre-installation environment, so called

"JumpStart Application Installation framework in to computers which uses Sun's operating systems,

where the framework discloses,

installing a pre-installation environment on a target computer that is desired to be imaged with a new

operating system (Sun' new operating systems, for example, installing newer version of Solaris, See part

1, start at p. 6, see all information in the boxes); re-booting the target computer in the pre-installation

environment (see part 1, p. 13, start at Begin to Install); deleting an old operating system from within the

pre-installation environment, (See, part 1, "delete in box 6, p. 8); installing the new operating system from

within the pre-installation environment (Using the Jumpstart, For example, installing new version of

Solaris); and re-booting the target computer in the new operating system; said acts being effective to in-

place image the target computer with the new operating system (user does this step; or see Part 2, p. 8,

first paragraph).

-Sun discloses claims 2-7, recited as,

2. the method of claim 1, wherein the act of installing the pre-installation environment comprises installing

the pre-installation environment in a same disk partition as the old operating system (in part 1, see,

Installation profile; in part 2, p. 9, p. 11, see disk repartitioning).

3. The method of claim 1 further comprising capturing data and state for migration to the new operating

system and migrating said captured data and state to the new operating system (refer to the act of

installation, e.g. newer version of Solaris is copied using the Jumpstart).

4. The method of claim 1 further comprising capturing machine data for migration to the new operating

system and migrating said captured machine data to the new operating system (refer to the act of

installation, e.g. newer version of Solaris is copied using the Jumpstart).

5. The method of claim 1 further comprising capturing user data for migration to the new operating system

and migrating said captured user data to the new operating system (refer to the act of installation, e.g.

newer version of Solaris is copied using the Jumpstart).

6. The method of claim 1 further comprising capturing user state for migration to the new operating

system and migrating said captured user state to the new operating system (refer to the act of installation,

e.g. newer version of Solaris is copied using the Jumpstart).

7. The method of claim 1 further comprising capturing client data for migration to the new operating

system and migrating said captured client data to the new operating system (refer to the act of

installation, e.g. newer version of Solaris is copied using the Jumpstart).

8. The claim 8 is indefinite because it merely recites instructions, and broadly includes with the limitations

in the method of claim 1. Therefore, with the rationale addressed in the rejection of claim 1, it applies for

this claim: One or more computer readable media having computer readable instructions thereon which,

when executed by one or more processors, cause the one or more processors to perform the method of
claim 1.

9. The claim 9 is indefinite because it merely recites program interfaces, and broadly includes with the
limitations in the method of claim 1. Therefore, with the rationale addressed in the rejection of claim 1, it
applies for this claim: A set of application program interfaces (APIs) configured to perform the method of
claim 1.

As per claim 10:

Sun discloses, A system comprising: one or more target computers each having one or more computer-
readable media; computer readable instructions on the one or more computer readable media which,
when executed by one or more processors, cause the one or more processors to perform a method
comprising: capturing data for migration to a new operating system, said data comprising one or more of
machine data, user data, and client data; installing a pre-installation environment on a target computer
that is desired to be imaged with a new operating system; re-booting the target computer in the pre-
installation environment; deleting an old operating system from within the pre-installation environment;
installing the new operating system from within the pre-installation environment; re-booting the target
computer in the new operating system; migrating said captured data to the new operating system; said
acts being effective to in-place image the target computer with the new operating system.,
because the claimed functionality appears to be a system. Sun discloses more than one target computer
that need to use the pre-installation environment at its server. And clearly Sun's JumpStart is related to
computer technologies, client-server, therefore it has computer readable instructions for the JumpStart,
and when the clients uses the JumpStart as a pre-installation environment, it performs the claimed steps
as shown in claim 1.

As per Claims 11-23:

Claim 11: Sun discloses claim 11. Sun discloses various boot images and a deployment, its deployment
is using a multi-phase process (Part1, p.2, table 1), which has a preparation such as using the Jumpstart;
its has deletion and load phase (shown in Part 1, p. 8) and using the profile information to install the new
operating system in to its target computer. Sun discloses, *imaging multiple target computers with a new*

operating system using a multi-phase image deployment process. Sun's user has used a multi-phase

image deployment process (Part1, p.2, table 1),

said multi-phase deployment process comprising at least:

a preparation phase in which various data is captured for migration to the new operating system (i.e.

deployment of a Solaris Installation server. See, Part 3, p.3. The JumpStart are used in deployment);

a wipe and load phase in which an old operating system is deleted and the new operating system is

installed in place (See Part 3, p. 5, first paragraph); and

a restoration phase in which captured data is migrated to the new operating system (Refer to "install", for

example see Part 3, p. 2, its purpose is to immigrate Solaris 8; and it appears Sun uses JumpStart for

copying this Operating system to each target that need for installation).

- Sun discloses claims 12-23,

Claim 12: With regard to limitation, *wherein the preparation phase can capture data associated with one*

or more of machine state, client state, user state and/or user data (The JumpStart provides configuration;

does identifications, for example, Part3, p. 4, i.e., identifying an install server; performs profiling,

installation option, p.11).

Claim 13: With regard to limitation, *wherein machine state data can comprise one or more of computer*

name, domain, and network settings (i.e. Sun shows identifying install server).

Claim 14: With regard to limitation, *wherein client state data can comprise Site association or code, client*

GUID, and an associated distribution point (i.e. Sun's servers).

Claim 15: With regard to limitation, *wherein user state data can comprise a user profile* (see installation

profile in Part 1, p. 8).

Claim 16: With regard to limitation, *wherein user data can comprise folders and files desired for migration*

and network share settings (see file system, in part 1, p. 9, "configuration information").

Claim 17: With regard to limitation, *wherein the preparation phase comprises installing a pre-installation*

environment from which in place installation can take place (i.e. Sun's Jumpstart is prepared to the Sun's

users).

Claim 18: With regard to limitation, *wherein the preparation phase comprises installing a pre-installation environment from which in place installation can take place, wherein the pre-installation environment comprises WinPE™ operating system* (functionality is equivalent to JumpStart™)

Claim 19: With regard to limitation, *wherein the wipe and load phase comprises enabling a target computer to connect with at least one of a number of destination points from which an image file containing the new operating system image is obtained* (Sun provides the user to identify install server where the sever contains new operating system; e.g. see Part 1, p. 2, Table 1; or see Part 3, p. 11).

Claim 20: With regard to limitation, *wherein the multi-phase image deployment process is configured to generate status reports during each of the phases, said status reports being transmittable to a system administrator to facilitate management of the image deployment process* (see Part3, p.14 syslog).

Claim 21: With regard to limitation, *wherein the multi-phase image deployment process is configured to generate status reports during each of the phases, said status reports being transmittable to a system administrator to facilitate management of the image deployment process, wherein status reports are generated by an old client associated with the old operating system, and a new client associated with the new operating system* (see Part3, p.14 syslog).

Claim 22: With regard to limitation, *One or more computer readable media having computer readable instructions thereon which, when executed by one or more processors, cause the one or more processors to perform the method of claim 11.* See the rejection of claim 11.

Claim 23: With regard to limitation, *A set of application program interfaces (APIs) configured to perform the method of claim 11.* See the rejection of claim 11.

<u>As per Claim 24</u>:

Sun discloses A system comprising: one or more target computers each having one or more computer-readable media; computer readable instructions on the one or more computer readable media which, when executed by one or more processors, cause the one or more processors to perform a method for remotely imaging multiple target computers with a new operating system comprising:

imaging multiple target computers with a new operating system using a multi-phase image deployment process, said multi-phase deployment process comprising at least: a preparation phase in which various data is captured for migration to the new operating system; a wipe and load phase in which an old operating system is deleted and the new operating system is installed in place; and a restoration phase in which captured data is migrated to the new operating system (See rationale addressed in Claim 11).

As per Claims 69-76:

69. Sun discloses, A method comprising:

remotely deploying a new operating system on one or more target computers by sending image packages containing an image of the new operating system to one or more distribution points and staging deployment from the one or more distribution points (See part 1, p.3, "Install Client", see part3, p. 3, deployment of new operating by using a JumpStart™, which is a multi-phase process) through multiple phases comprising at least: a preparation phase in which various data is captured for migration to the new operating system; a wipe and load phase in which an old operating system is deleted and the new operating system is installed; and a restoration phase in which captured data is migrated to the new operating system (See rationales addressed in Claim 11);

generating status reports within each of the phases, at least some of the status reports describing events that occur during an associated phase; and transmitting the status reports to a system administrator (For example, See part 3, p. 5, Figure 1, a statutes report such as "delete", and this is within a profile configured by an administration; i.e. see "Profiles" in p. 4).

70. Sun discloses, The method of claim 69, wherein the wipe and load phase installs the new operating system in place (Part 3, see p. 3, using install server).

71. Sun discloses, The method of claim 69, wherein said act of transmitting the status reports is accomplished, at least in part, by an old client executing on an operating system that is replaced, and a new client executing on the new operating system (It is nature of the art; after a new software is installed).

72. Sun discloses, The method of claim 69, wherein the preparation phase can capture data associated with one or more of machine state, client state, user state, and/or user data ("delete" is a capture of a machine state).

73. Sun discloses, The method of claim 69, wherein the preparation phase comprises installing a pre-installation environment from which in place installation can take place (refer to Solaris Operating Environment).

74. Sun discloses, One or more computer readable media having computer readable instructions thereon which, when executed by one or more processors, cause the one or more processors to perform the method of claim 69 (See rationale addressed in Claim 69).

75. A set of application program interfaces (APIs) configured to perform the method of claim 69 (See rationale addressed in Claim 69).

76. Sun discloses, A system comprising: one or more computers each having one or more computer-readable media; computer readable instructions on the one or more computer readable media which, when executed by one or more processors, cause the one or more processors to perform a method comprising: remotely deploying a new operating system on one or more target computers by sending image packages containing an image of the new operating system to one or more distribution points and staging deployment from the one or more distribution points through multiple phases comprising at least: a preparation phase in which various data is captured for migration to the new operating system; a wipe and load phase in which an old operating system is deleted and the new operating system is installed; and a restoration phase in which captured data is migrated to the new operating system; generating status reports within each of the phases, at least some of the status reports describing events that occur during an associated phase; and transmitting the status reports to a system administrator (See rationale addressed in Claim 69).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as
set forth in section 102 of this title, if the differences between the subject matter sought to be
patented and the prior art are such that the subject matter as a whole would have been obvious
at the time the invention was made to a person having ordinary skill in the art to which said
subject matter pertains. Patentability shall not be negatived by the manner in which the invention
was made.

8.   Claims 25-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlak, "Software

Update Service to Ease Patch Distribution", DirectiononMicrosoft.com, in view of Sun Microsystems

(Hereafter Sun): "JumpStart™ Mechanics: Using JumpStart Application for Hands-Free Installation of

Unbundled Software", (hereinafter Part1);

"JumpStart™ Mechanics: Using JumpStart Application for Hands-Free Installation of Unbundled

Software – Part 2" (hereinafter Part2);

and "Upgrading to the Solaris™ 8 Operating Environment" (hereinafter Part3).

Claims 25-31:

<u>As per claim 25</u>:

25. Pawlak discloses, *A method comprising: notifying a target computer user that a new operating system*

image is desired to be deployed on the target computer (e.g. see p.3-4, "Automatic Update Client": it

teaches SUS client is notified to get applicable packages); *and providing the user with an option to*

postpone image deployment on the target computer (See p. 3, last paragraph. See A1-3, the options, and

descriptions within check boxes. Also see A1-A2).

However, before providing notifying the target user and proving an option, Sun discloses

installing a pre-installation environment on the target computer that is desired to be imaged with a

new operating system; re-booting the target computer in the pre-installation environment;

deletinq an old operating system from within the pre-installation environment;

installing the new operating system from within the pre-installation environment;

re-bootinq the target computer in the new operatinq system;

(Citations for the above limitation is addressed in the claim 1).

It would have been obvious to a person of ordinary skill in the art at the time the invention was

made to combine the teaching of Pawlak, characterized as for notifying and providing a user with options

as in the rationale within the Claim above, and the teaching for installation of new operating system of

SUN. The combination is obvious because in an installation of new operating system, it requires deleting

old operating system and rebooting the new operating as a requirement of operating system installation

as being a known method ready to yield predictable results (See Supreme Court Decision in KSR

International Co. v. Teleflex Inc.).

As per Claims 30-31: Applied the same to Claim 25.

Claims 26-29: Pawlak further discloses:

26. Pawlak discloses, The method of claim 25 further comprising providing the user with an option to

disallow image deployment on the target computer (See A1-A2, for example unchecked).

27. Pawlak discloses, The method of claim 25 further comprising providing the user with an option to

immediately begin an image deployment process on the target computer (See A1-A2, for example

approve, or the act of downloading by a user in A1).

28. Pawlak discloses, The method of claim 25 further comprising providing the user with an option to

disallow image deployment process on the target computer, and an option to immediately begin an image

deployment process on the target computer (See A1-A3).

29. Pawlak discloses, The method of claim 25, wherein the act of providing comprises allowing the user

to specify a postponement duration (See A2-A3, 'set options').

As per claims 32-34: See rationale addressed in Claim 25.

Claim 35-41:

<u>As per claim 35</u>: Pawlak discloses,

A method comprising: creating an operating system image (see A2-A3, "Software Update Service', that

has lists of software images available for update)

that is to be deployed across a plurality of target machines (See A6), said image comprising at least one

image file (See in A2-A3); creating an image package that contains said one image file, at least a

deployment environment, tools and configuration files for installing the image on said target machines

(see A1, and Web Interfaces, of A2-3); and distributing the image package to one or more distribution

points from which individual target machines (see p.4, last paragraph, "Fan-out architecture") can access

the image package (See A6).

However, **wherein the image package,** Sun discloses ***image packaqe is installed in a pre-installation***

environment on the individual target machine that has deleted the target machine's old

operating system.

(Citations for the above limitation is addressed in the claim 1).

It would have been obvious to a person of ordinary skill in the art at the time the invention was

made to combine the teaching of Pawlak, characterized as for creating and deploying an image package

as in the rationale in Claim 35, and the teaching for installation of new operating system of SUN. The

combination is obvious because in an installation of new operating system, it requires deleting old

operating system and rebooting the new operating as a requirement of operating system installation as

being a known method ready to yield predictable results (See Supreme Court Decision in KSR

International Co. v. Teleflex Inc.).

<u>As Claims 39-41</u>: Applied the same to Claim 35.

<u>As per claims 36-38</u>: Pawlak further discloses:

36. Pawlak discloses, The method of claim 35, wherein said deployment environment comprises

WinPE™ operating system (See the reference, e.g. Scenarios in A6, refer the windows used in the

Client's computer).

37. Pawlak discloses, The method of claim 35, wherein said one or more distribution points comprise one

or more file shares (See AutoUpdate Configuration in page 4).

38. Pawlak discloses, The method of claim 35 further comprising generating an advertisement for the image package and sending the advertisement to one or more of the target machines, said advertisement being configured to advise target machine users that a new operating system is desired to be deployed on their machine (See A1, and/or A6).

Claims 42-49:

As per claim 42:

42. Pawlak discloses, A method comprising: creating an operating system image that is to be deployed across a plurality of target machines, said image comprising one or more image files; creating an image package that contains said one or more image files and at least a deployment environment for installing the image on said target machines; distributing the image package to one or more distribution points from which individual target machines can access the image package (See rationale addressed in Claim 35); notifying a target machine user that a new operating system image is desired to be deployed on the target machine; and providing the user with an option to postpone image deployment on the target machine (e.g. see p.3-4, "Automatic Update Client": it teaches SUS client is notified to get applicable packages). However, after providing notifying the target user with an option, Sun discloses

installing a pre-installation environment on the target computer that is desired to be imaged with the new image; re-booting the target computer in the pre-installation environment;

deleting an image from within the pre-installation environment;

installing the new operating system from within the pre-installation environment;

re-booting the target computer in the new image package.

(Citations for the above limitation are addressed in the claim 1).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Pawlak, characterized as for creating an operating system and providing a user with options as in the rationale within the Claim above, and the teaching for installation of new operating system of SUN. The combination is obvious because in an installation of new operating system, it requires deleting old operating system and rebooting the new operating as a requirement of operating

system installation as being a known method ready to yield predictable results (See Supreme Court

Decision in KSR International Co. v. Teleflex Inc.).

As per claims 47-49: See rationale addressed in the rejection of claim 42.

As per claims 43-46: Pawlak further discloses:

43. Pawlak discloses, The method of claim 42 further comprising providing the user with an option to

disallow image deployment on the target machine (See A2-3).

44. Pawlak discloses, The method of claim 42 further comprising providing the user with an option to

immediately begin an image deployment process on the target machine (See A2-3).

45. Pawlak discloses, The method of claim 42 further comprising providing the user with an option to

disallow image deployment process on the target machine (such as unchecked) and an option to

immediately begin an image deployment process on the target machine (such as click on approved or

use download).

46. Pawlak discloses, The method of claim 42, wherein the act of providing comprises allowing the user

to specify a postponement duration (See A2-A3, set options, checked boxes, etc).

As per claims 50-58:

Pawlak discloses creating and operating image and deploy the image to target computer as rationale in

Claim 42, and does not explicitly address rebooting as recited in the manner of claims 50-58, where,

-Claim 50 combines the teaching of Claim 42 (Pawlak) and Claim 1 (Sun).

-Claim 51 combines the teaching of Claim 42 (Pawlak) and Claim 3 (Sun).

-Claim 52 combines the teaching of Claim 42 (Pawlak) and Claim 4 (Sun).

-Claim 53 combines the teaching of Claim 42 (Pawlak) and Claim 5 (Sun).

-Claim 54 combines the teaching of Claim 42 (Pawlak) and Claim 6 (Sun).

-Claim 55 combines the teaching of Claim 42 (Pawlak) and Claim 7 (Sun).

-Claims 56-57, each combines the teaching of Claim 42 (Pawlak) and Claim 1 (Sun).

-Claim 58 combines the teaching of Claim 42 (Pawlak) and Claim 1 (Sun).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Pawlak, characterized as for creating and operating image and deploy the image to target computer as rationale in Claim 42, and the teaching for installation of new operating system of SUN in a target computer as rationale in Claims 1-7. The combination is obvious because in an installation of new operating system, it requires deleting old operating system and rebooting the new operating as a requirement of operating system installation as being a known method ready to yield predictable results (See Supreme Court Decision in KSR International Co. v. Teleflex Inc.).

As per claims 59-65, 66-68:

Pawlak discloses creating and operating image and deploy the image to target computer as rationale in Claim 42, and does not explicitly address using the phases for rebooting as recited in the manner of claims 59-65, where,

-Claim 59 combines the teaching of Claim 42 (Pawlak) and Claim 11 (Sun).

-Claim 60 combines the teaching of Claim 42 (Pawlak) and Claim 17 (Sun).

-Claim 61 combines the teaching of Claim 42 (Pawlak) and Claim 19 (Sun).

-Claim 62 combines the teaching of Claim 42 (Pawlak) and Claim 20 (Sun).

-Claim 63 combines the teaching of Claim 42 (Pawlak) and Claim 21 (Sun).

-Claims 64-65, each combines the teaching of Claim 42 (Pawlak) and Claim 11 (Sun).

-Claim 66 is a system that combines the teaching of Claim 42 (Pawlak) and Claim 11 (Sun).

-Claim 67 is a system that combines the teaching of Claim 42 (Pawlak) and Claim 20 (Sun).

-Claim 68 is a system that combines the teaching of Claim 42 (Pawlak) and Claim 21 (Sun).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Pawlak, characterized as for creating and operating image and deploy the image to target computer as rationale in Claim 42, and the teaching for installation of new operating system of SUN in a target computer as rationale in Claims 11, 17, 19-21. The combination is obvious because in an installation of new operating system, it requires deleting old operating system and

rebooting the new operating as a requirement of operating system installation as being a known method
ready to yield predictable results (See Supreme Court Decision in KSR International Co. v. Teleflex Inc.).

Conclusion

9.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office

action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of

the extension of time policy as set forth in 37 CFR 1.136(a).

        A shortened statutory period for reply to this final action is set to expire THREE MONTHS from

the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date

of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

shortened statutory period, then the shortened statutory period will expire on the date the advisory action

is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX

MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be

directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be

reached on 8:00AM to 4:30PM.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei

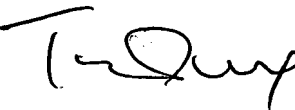Y. Zhen can be reached on (571) 272-3708.

        The facsimile number for the organization where this application or proceeding is assigned is the

Central Facsimile number **571-273-8300**.

        Any inquiry of a general nature or relating to the status of this application should be directed to

the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may

be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for

unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 2191

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTV
October 12, 2007

TED VO
PRIMARY EXAMINER